

Attorney Docket No.: 1243.LUKP:125US
Application No. 10/711,848
Amendment Date: October 10, 2007
Reply to Office Action of July 25, 2007

Amendments to the Drawings

Figure 2 has been deleted.

Remarks/Arguments

Objection to the Specification

The amendments filed June 12, 2007 were objected to under 35 U.S.C. 132(a). In particular, the Examiner objected to changes to newly added Figure 2. Applicants have deleted Figure 2 and paragraph [0021.1], which describes Figure 2. Applicants have amended paragraph [0019] to remove reference to Figure 2. Therefore, the objection is moot and Applicants courteously request that the objection be removed.

Objection to the Drawings

The drawings filed June 12, 2007 were objected to under 35 U.S.C. 132(a). In particular, the Examiner objected to changes to newly added Figure 2. Applicants have deleted Figure 2. Therefore, the objection is moot and Applicants courteously request that the objection be removed.

The Rejection of Claims 9-22 Under 35 U.S.C. § 102(b)

Claims 9-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,408,898 (Steeby et al.). Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

“A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference.” *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).” MPEP §2131.

Claim 9

Steeby does not describe an adjustment of reference travel

Claim 9 recites: “means for adjusting at least one reference travel.” The Examiner has stated: “Steeby et al show a gearbox actuation system (see Figs 1 and 2) for selecting and shifting gears in an automated gearbox of a vehicle comprising: means 23 for adjusting at least one reference travel (i.e., gear speed ratio).” Applicants respectfully submit that the Examiner has incorrectly equated “gear speed ratio” with “reference travel.” That is, as described *infra*, the

Examiner has incorrectly equated using a shift finger to change a gear speed ratio (as described by Steeby) with using a shift finger to adjust reference travel (as recited in Claim 9).

“Although limitations from the specification are not read into the claims, the claims are to be read in light of the specification. *In re Van Geuns*, 988 F.2d 1181, 26 U.S.P.Q.2d 1057 (Fed. Cir. 1993).”

“This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004).”

“[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (*en banc*). *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298, 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) (“In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art.”). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the “ordinary” and the “customary” meaning of the terms in the claims. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003).”

The plain meaning of “reference travel,” in the art is with respect to the movement of a shift finger within a gearbox actuation system. The plain meaning is not a gear speed ratio. The specification for the instant application does not include an express intent to impart a novel meaning to the term “reference travel” and fully supports and is in full alignment with this plain meaning. For example, paragraph [0021] of the instant application defines reference travel as the movement of shift finger 24 within the gearbox actuation system and not a gear speed ratio. Specifically, paragraph [0021] defines referencing as “the reference travel of moving shift finger 24 within recess 30 according to second bi-directional arrow 32.”

In contrast, gear speed ratios merely describe different proportional output speeds that can be achieved from the same input speed. That is, gear speed ratios are parameters that are derived from the configuration of a gear assembly and have nothing to do with the movement of elements used to shift the gear assembly. For example, the reference travel of the claimed invention is a space and distance used to calibrate an actuation system. The movement of shift finger **24** may result in changing a gear ratio; however, such changing is an all together different operation from adjusting reference travel for the finger.

“An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).” “Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999).”

Assuming *arguendo* that Applicants have defined “reference travel” in a manner different than the plain meaning as understood in the art (for example, the definition noted *supra* in paragraph [0021] differs from the plain meaning of the term “reference travel”), Claim 9 must be examined in light of the definition provided in the instant application. Thus, “reference travel” must be interpreted as defined in paragraph [0021] of the instant application.

In summary, both the plain meaning in the art and the instant specification define a reference travel as the movement of the shift finger **24** within gap **25** and recess **30**. Therefore, the definition of a reference travel must be interpreted in the claims as it is defined in the specification, which is the movement of shift finger **24** within gap **25** and recess **30**.

Element 23 of Steeby is a shift finger and Steeby teaches the use of the shift finger to preload shift rails and to move shift rails (see Abstract). Steeby further teaches the use of the shift finger to move shift rails in col. 2, lines 27-33; and col. 4, lines 10-18/29-35/58-61. The section labeled “OPERATION” (col. 6, line 32 to col. 7, line 45) also describes the rail shifting operation of finger 23 without reference to adjusting the reference travel for the finger.

As is well known in the art, shift rails are moved by shift fingers to change gear speed ratios and this is the operation taught by Steeby. However, Steeby has no teaching regarding the

adjustment of the reference travel for shift finger 23. That is, using the shift finger to move a shift rail (change a gear ratio) is not the same as adjust reference travel for the shift finger.

For all the reasons noted above, Steeby fails to teach all the elements of Claim 9. Therefore, Claim 9 is novel with respect to Steeby. Claims 10-22, dependent from Claim 9, enjoy the same distinction with respect to Steeby.

Applicants courteously request that the rejection be removed.

Conclusion

For all the reasons outlined above, Applicants respectfully submit that the claims are patentable over the cited reference and in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,

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